Remarks/Arguments

Claims 1-17 remain in the application. Claims 1-17 are rejected. Claims 2, 4 and 5 are currently amended.

Claim Rejections - 35 USC § 103

Claims 1, 6, 9, 11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper (US 6,883,000 B1) in view of Schiller (U.S. 2001/0032089 A1).

Applicant traverses the rejection of claim 1 as being unpatentable over Gropper in view of Schiller. In particular, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness. Applicant's arguments are outlined below, beginning with a discussion of the scope and contents of the prior art.

Gropper teaches a server/client system in which a "card holder (issuer) of business cards subscribes to a server system, thus becoming a subscriber, and provides all of his/her contact information to the server system" (col. 3, lines 61-64). Clearly, it is the subscriber that provides his (or her) **own** contact information directly to the server system. A separate file is created on the server system for contact information that is provided by each different subscriber, and each file is represented by a unique alpha-numeric identifier referred to as a Universal Contact Locator or "UCL." The subscriber distributes the unique UCL to one or more users i.e. a recipient of business cards having the UCL imprinted thereon. After registering with the sever system and downloading and installing a client program, the user enters the UCL into the client program. The client program then passes the UCL to the server system via a remote network. The server system accesses the subscriber's file (stored on the server system) that is associated with the UCL that was just passed to the server system from the client program. The server system passes the contact and advertising information associated with the subscriber UCL to the client program via the remote network. '

In every embodiment and variation that is described by Gropper, a server system stores a plurality of electronic files, wherein each electronic file contains contact and advertising information that is provided by a different subscriber to the server system. A unique UCL is associated with each electronic file to facilitate indexing and retrieval of the information. Generally speaking, the system allows a subscriber to distribute the UCL to users (card recipients) such that the users may, if they wish, connect to the server and provide the UCL in order to obtain stored additional information relating to the subscriber.

Schiller discloses a method of updating a contact database, in which contact information e.g. names, addresses and numbers, indicative of individuals is stored in the database. Update requests are generated from a database manager to the individuals, requesting that the contact information be updated. Incentives are provided if contact information is updated in response to a request. Schiller states that for a database that is managed on-line, the requests are preferably transmitted by e-mail messages to the individuals themselves. The requests are preferably electronically generated once predetermined thresholds, e.g., the passage of a set period without any updates, are reached.

Although Schiller teaches sending a message directly to an individual, this only occurs when the individual is an existing contact, and not when the individual is a new contact. Generally speaking, Schiller teaches a method for obtaining updated or recent information directly from existing contacts, and not for obtaining additional contact information from a new contact.

The Examiner states at page 3 of the Official Action mailed on 10/24/2005 that Gropper "does not explicitly disclose the request for additional contact information being sent directly to the new contact." Of course, Applicant agrees with this statement. Clearly, Gropper teaches that a user enters one (or more) UCL(s) into the client program, which stores the UCL(s) locally until such time a connection to the server system is established. The UCL(s) is/are passed **to the server system** and the sever system subsequently passes contact and advertising information associated with the UCL(s) back to the client program.

The Examiner further states at page 4 of the Official Action mailed on 10/24/2005 that one "of ordinary skill in the art at the time of the applicant's invention would have found it obvious to implement the step of sending a message directly to a contact requesting updated information as disclosed by Schiller in combination with the contact management database disclosed by Gropper. One of ordinary skill in the art would have been motivated to implement this step in order for a user to be able to have an up to date contact database that is constantly being updated by the best person, the best person being the person who updates information in respect to themselves..." Applicant does not concur. In fact, **Applicant respectfully submits that the proposed combination is unmotivated**. For instance, Gropper clearly teaches at col. 3, lines 61-64, that the subscriber (e.g. issuer of business cards) provides all of his/her contact information to the server system. Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to make the proposed combination, in view of the fact that Gropper explicitly teaches that the contact information *is* provided by the "best person," in this case the subscriber to the server system.

Applicant respectfully submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time the invention was made, to combine the reference teachings as suggested by the Examiner. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

Applicant further submits that the proposed combination would change the principle of operation of the prior art invention being modified. In particular, the prior art discloses a method based on a server/client system in which: multiple subscribers provide contact and advertising information to a centralized server system; the information provided by each subscriber is stored in a separate file within the centralized server system; a unique UCL is associated with each file and provided to the respective subscriber; the subscriber distributes the unique UCL to many users; and the many users all connect to the centralized server system in order to retrieve information relating to the subscriber using the UCL to identify the relevant file. It would involve substantial reconstruction and redesign amounting to a change in the basic principle of operation of the prior art invention

8

to make the proposed combination so as to omit the centralized server system and send requests for contact and advertising information from the users directly to the subscriber. Accordingly, Applicant respectfully submits that the proposed combination is not proper.

In view of the argument presented above, Applicant submits that claim 1 is in proper condition for allowance. Favorable consideration is kindly requested.

Applicant traverses the rejection of claim 6 as being unpatentable over Gropper in view of Schiller. Claim 6 recites a step of "verifying the authenticity of each electronic message received at a system of the new contact." In fact, an electronic message is sent to the system of the new contact for the purpose of requesting additional contact information, some of which may be personal or confidential in nature. Verifying the authenticity of each electronic message as claimed at claim 6 ensures that the additional contact information is being provided to an authorized recipient. Gropper does not teach such a method step. In fact, at col. 6, lines 54-57 Gropper merely states that it is desirable to notify prior recipients in the event a subscriber's contact information changes. Accordingly, no combination of the teachings of Gropper and Schiller results in the invention as claimed at claim 6. Applicant respectfully submits that claim 6, which depends indirectly from believed allowable claim 1, is also in proper condition for allowance. Favorable consideration is kindly requested.

Applicant traverses the rejection of claim 9 as being unpatentable over Gropper in view of Schiller. In particular, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness. Furthermore, in the case of claim 9 the Examiner has disregarded the requirement of analyzing the claimed subject matter "as a whole", by simply stating at page 4, item 10, "Claim 9 contains similar subject matter and is rejected under the same rationale as claim 1. Regarding the use of an inbox the method of storing messages within the inbox, Schiller discloses the use of an e-mail application to send and receive electronic messages…therefore it is deemed inherent for the e-mail application to include an e-mail inbox as is well known in the art."

Claim 9 recites a step of "using an automated reply filter cooperatively in execution with the electronic message application, intercepting the received electronic message **prior**

to storage thereof within an inbox of the electronic message application." No combination of Gropper and Schiller teaches this step. In fact, the method of Schiller is based entirely upon offering incentives to contacts in exchange for updating their own contact information. Schiller teaches at paragraph [0021] "In an on-line managed database, the manager will preferably generate requests for updated information in the form of an e-mail message and send it to a respective individual's last known e-mail address. The individual is then prompted to respond, either with updated information or with a message that no update is necessary." Clearly, Schiller does not teach or suggest using an automated reply filter. Rather, the individual must access the electronic message and subsequently respond to the message in order to receive the incentive.

Applicant further submits that no combination of Gropper and Schiller teaches the steps of "using an electronic message application in execution on a system of the new contact, receiving an electronic message transmitted from the user system..." and "transmitting the generated new electronic message to the user system..." As discussed with reference to claim 1, Gropper teaches that a user enters one (or more) UCL(s) into the client program, which stores the UCL(s) locally until such time a connection to the server system is established. The UCL(s) is/are passed **to the server system** and the sever system subsequently passes contact and advertising information associated with the UCL(s) back to the client program. Gropper does not teach or suggest exchanging electronic messages directly between the new contact and the user, the server system is always interposed between the two.

Accordingly, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to claim 9. Claim 9 is believed to be in proper condition for allowance, and favorable consideration is kindly requested.

Claim 11 depends indirectly from believed allowable claim 9 and is also believed to be in allowable form. Favorable consideration is kindly requested.

Applicant traverses the rejection of claim 14 as being unpatentable over Gropper in view of Schiller. In particular, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness. The same arguments that were presented

with reference to claim 1 also apply to claim 14 *mutatis mutandis*. Favorable consideration is kindly requested.

Claims 15 and 16 depend either directly or indirectly from believed allowable claim 14 and are also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

> *Claims 2-5, 7, 8, 10, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper (US 6,883,000 B1).*

As a preliminary note, Applicant is uncertain as to why dependent claims 2-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper when independent claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper **in view of Schiller**. A similar question arises concerning the rejection of claims 10, 12, 13 and 17. Applicant respectfully submits that the rejection of claims 2-5, 7, 8, 10, 12, 13 and 17 is improper, since by definition each dependent claim contains all of the limitations of the independent claim and any intervening claims. Clarification is requested.

Claim 2 has been amended to correct a minor antecedence error. Specifically, the term "the user" has been amended to read "a user of the user system." No new matter has been added. The Examiner has stated at page 3 of the Official Action mailed on 10/24/2005 that Gropper *alone* does not explicitly disclose the limitation recited at claim 1, "sending a message including a request for additional contact information to the contact destination of the new contact." Since claim 2 depends from claim 1, and therefore includes all of the limitations of claim 1, Applicant respectfully submits that claim 2 is patentable over Gropper. Accordingly, claim 2 is believed to be in proper condition for allowance. Favorable consideration is kindly requested.

The Examiner has stated at page 3 of the Official Action mailed on 10/24/2005 that Gropper *alone* does not explicitly disclose the limitation recited at claim 1, "sending a message including a request for additional contact information to the contact destination of the new contact." Since claim 3 depends from claim 1, and therefore includes all of the limitations of claim 1, Applicant respectfully submits that claim 3 is patentable over

11

Gropper. Accordingly, claim 3 is believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Claim 4 has been amended in order to correct a minor antecedence error. In particular, the phrase "the received return electronic message" has been amended to read "the received return message." No new matter has been added. The Examiner has stated at page 3 of the Official Action mailed on 10/24/2005 that Gropper *alone* does not explicitly disclose the limitation recited at claim 1, "sending a message including a request for additional contact information to the contact destination of the new contact." Since claim 4 depends from claim 1, and therefore includes all of the limitations of claim 1, Applicant respectfully submits that claim 4 is patentable over Gropper. Accordingly, claim 4 is believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Claim 5 has been amended in order to correct a minor antecedence error. In particular, the term "the user" has been amended to read "a user of the user system." No new matter has been added. Having regard now to claims 5 and 17, Applicant respectfully submits that Gropper teaches the reverse of what is claimed at claims 5 and 17. In particular, Gropper states at col. 3, lines 61-64, "In the present invention, a card holder (issuer) of business cards subscribes to a server system, thus becoming a subscriber, and provides all of his/her contact information to the server system." According to the terminology that is used by Gropper, it is the individual that is providing the contact information ("the new contact") that subscribes to a service, **not** the user of the electronic contact information database. Accordingly, claims 5 and 17 are believed to be patentable over Gropper.

Furthermore, the Examiner has stated at page 3 of the Official Action mailed on 10/24/2005 that Gropper *alone* does not explicitly disclose the limitation recited at claim 1, "sending a message including a request for additional contact information to the contact destination of the new contact." Since claim 5 depends from claim 1, and therefore includes all of the limitations of claim 1, Applicant respectfully submits that claim 5 is patentable over Gropper. Similarly, since claim 17 depends from claim 14 and therefore

includes all of the limitations of claim 14, Applicant respectfully submits that claim 17 is patentable over Gropper. Accordingly, claims 5 and 17 are believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Having regard to claim 7, Applicant fails to understand the Examiner's line of reasoning and the relevance of the reference to col. 5, lines 16-29. Nevertheless, the Examiner has stated at page 3 of the Official Action mailed on 10/24/2005 that Gropper *alone* does not explicitly disclose the limitation recited at claim 1, "sending a message including a request for additional contact information to the contact destination of the new contact." Since claim 7 depends from claim 1, and therefore includes all of the limitations of claim 1, Applicant respectfully submits that claim 7 is patentable over Gropper. Accordingly, claim 7 is believed to be in proper condition for allowance. Favorable consideration is kindly requested.

The Examiner has stated at page 3 of the Official Action mailed on 10/24/2005 that Gropper *alone* does not explicitly disclose the limitation recited at claim 1, "sending a message including a request for additional contact information to the contact destination of the new contact." Since claim 8 depends from claim 1, and therefore includes all of the limitations of claim 1, Applicant respectfully submits that claim 8 is patentable over Gropper. Accordingly, claim 8 is believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Claim 10 depends from believed allowable claim 9 and is also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Claim 12 depends from believed allowable claim 9 and is also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Applicant respectfully traverses the rejection of independent method claim 13 as being unpatentable over Gropper. Gropper does not teach a step of "automatically transmitting an electronic message from the user system *to a system of the new contact....*" In fact, the Examiner has stated at page 3 of the Official Action mailed on 10/24/2005 that Gropper *alone* does not explicitly disclose transmitting a message directly to the new

contact. Clearly, Gropper teaches that a user enters one (or more) UCL(s) into client program, which stores the UCL(s) locally until such time a connection to the server system is established. The UCL(s) is/are passed **to the server system** and the sever system subsequently passes contact and advertising information associated with the UCL(s) back to the client program.

A Petition for Extension of Time is filed concurrently with this response.

Applicant is also submitting under separate cover an information disclosure statement including three new references of which the Applicant has recently become aware. Applicant is of the opinion that the new references **are not** material to the patentability of the claims currently on file. That being said, Applicant wishes to provide the Examiner the opportunity to independently make such a determination regarding the new references.

Please charge any additional fees required or credit any overpayment to Deposit Account No. 50-1142.

Applicant requests favourable reconsideration of the amended application.

Respectfully submitted,

Gordon Freedman, Reg. No. 41,553

Freedman and Associates   Tel: (613) 274-7272
117 Centrepointe Drive, Suite 350   Fax: (613) 274-7414
Nepean, Ontario
K2G 5X3 Canada

MW/sah